# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/652,360 | 08/31/2000 | Leon Wong | 418268758US | 4462 |

| 45979          7590          04/14/2006 | EXAMINER |
|---|---|
| PERKINS COIE LLP/MSFT | WIDHALM, ANGELA M |
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| | ART UNIT | PAPER NUMBER |
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| SEATTLE, WA  98111-1247 | 2152 | |

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/652,360 | WONG ET AL. |
| | Examiner | Art Unit | |
| | Angela Widhalm | 2152 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>09 February 2006</u>.

2a)☐ This action is **FINAL**.          2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>26-50</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>26-50</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *  c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.     A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection.  Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.  Applicant's submission filed on 9

February 2006 has been entered.

2.     The claims 26-50 are pending in this application.  Claims 1-25 have been

cancelled.  Claims 26, 30, 38, and 46 have been amended.

### *Claim Rejections - 35 USC § 101*

3.     35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.     Claims 26-29 and 46-50 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.  Claims 26-29 and 46-50 are not

limited to tangible embodiment.  In view of Applicant's disclosure, specification pg. 9

lines 9-17 and pg. 10 lines 14-17, the computer-readable medium is not limited to

tangible embodiments, instead being defined as including both tangible embodiments

(e.g., optical or magnetic storage media or memory media such as RAM, ROM,

EEPROM, CD-ROM) and intangible embodiments (e.g., conveyed via a communication

medium such as hardwired or wireless). As such, the claims are not limited to statutory

subject matter and are therefore non-statutory.


### *Claim Rejections - 35 USC § 112*

5.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.      <u>Claims 26, 30, 38, and 46 are rejected under 35 U.S.C. 112, second paragraph,
as being indefinite for failing to particularly point out and distinctly claim the subject
matter which applicant regards as the invention.</u>


7.      Regarding claims 26, 30, 38, and 46, Applicant claims the controlling client

computer system is different from the client computer system, but Applicant does not

claim how they differ. According to Applicant's specification (pg. 20 lines 9-11), client

computer system 220e is the controlling client computer system and controls which

authentication methods are acceptable for client computer systems 220a through 220d

in addition to which authentication methods are acceptable for itself. The controlling

client computer system is still a client computer system (see specification pg. 20 lines 9-

11, pg. 19 lines 19-22).

Examiner identifies multiple ways in which the controlling client computer system

could be different from the requesting client computer system. One way is for the

controlling client computer system to be physically separate from the requesting client

computer system, e.g. a web server acting as a gateway between a user and the

Internet. Another way is for the controlling client computer system to be in the same

computer system as the requesting client computer system and differentiate itself

according to a process, e.g. a superuser has administrative control over the

authentication of another user. For purposes of examination, Examiner assumes the

second way.


8.      Regarding claims 26, 30, 38, and 46, Applicant claims the authentication method

selection is based on the client computer system's authentication abilities and access

rights. Applicant gives examples of authentication abilities (see specification page 15

line 19 – page 16 line 4; *client computer systems 220c and 220d have capabilities to*

*authenticate using methods 211-214, but methods 212-214 are incompatible with server*

*computer system 210 and so client computer systems 220c and 220d are only able to*

*authenticate with server computer system 210 using method 211*) and access rights

(see specification page 19 lines 1-2; *client computer systems 220c and 220d have*

*access rights to perform harmless operations*), but Applicant does not define what

authentication abilities and access rights are. For purposes of examination, Examiner

interprets authentication abilities to mean that a system is capable of authenticating and

being authenticated by a system. For purposes of examination, Examiner interprets

access rights to mean a system has access rights after a positive authentication.

9.      Claims 26, 30, 38, and 46 are rejected under 35 U.S.C. 112, second paragraph,

as being incomplete for omitting essential elements, such omission amounting to a gap

between the elements.  See MPEP § 2172.01.  The omitted elements are:

a.      Regarding claims 26 and 38, Applicant claims the use of the

authentication fields and authentication methodologies by the server computer

system for authenticating requesting client computer systems.  There is no

explanation of how the server computer system has access to the authentication

fields and authentication methods.


b.      Regarding claims 30 and 46, Applicant claims a method and computer-

readable medium in which a controlling client computer system sends an

instruction indicating a selected authentication method.  Although according to

the preamble in claim 30, the method is located in a server computer, Applicant

does not claim in either claim 30 or claim 46 which computer system – the client

computer system, the controlling client computer system, or the server computer

– receives the instruction indicating an authentication methodology or which

computer system – the client computer system, the controlling client computer

system, or the server computer – authenticates the client computer system.


c.      Regarding claim 38, Applicant claims a method that generates an

instruction indicating a selected authentication method and sends the instruction

to a server computer system.  Although according to the preamble, the method is

located in a controlling client computer system, Applicant does not claim which

computer system – the client computer system, the controlling client computer

system, or the server computer system – generates the instruction indicating an

authentication methodology or which computer system – the client computer

system, the controlling client computer system, or the server computer system –

sends the instruction to the server computer system.

## *Claim Rejections - 35 USC § 103*

10.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.     Claims 26-33, 35, 38-41, 43, and 46-49 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Wood et al. (U.S. Patent 6,691,232), hereafter referred to as

Wood, in view of Lim (U.S. Patent 6,728,884).

12.     Regarding claim 26, Wood disclosed a computer-readable medium having stored

thereon a data structure having a plurality of fields, the data structure comprising:

a plurality of client identifier fields (see col. 11 lines 39-41; Fig 4 #410; *user ID*)

that each identify a client computer system that is connected to a server computer

system (see col. 11 lines 50-55; *user logs in via an HTML browser*); and

for each identified client computer system, the data structure further comprising

at least one authentication field (see col. 11 lines 40-45; *credentials are authenticated*)

that identifies an authentication method (see col. 11 lines 40-47; *user selects an*

*authentication scheme*) to be used by the server computer system for authenticating the

client computer system upon receiving a request from the client computer system for

service, the authentication method having been selected (see col. 11 lines 45-47; *user*

*selects an authentication scheme*) based on authentication abilities and access rights of

the client computer system (see col. 11 lines 52-56; *user enters login credentials*) so

that the client computer system need not unnecessarily reveal secret information.


Wood did not explicitly disclose a controlling client computer system, e.g.

Registry Server, that has a different process than the client computer system nor that

the controlling client system controls which authentication method is used.

However, in an analogous art, Lim disclosed a Registry Server 108 containing

information on how a user should be authenticated (see col. 6 lines 11-19). The

Authentication and Authorization Module 114 in the Access Server 106 uses this

authentication information to authenticate the user (see col. 5 line 61 – col. 6 line 10).

It would have been obvious to one of ordinary skill in this art at the time of

invention to incorporate an authentication registry containing information about how a

user should be authenticated into Wood's authentication system. This would increase

security by allowing a third entity to control a user's authentication.

13.     Regarding claim 27, Wood-Lim disclosed each client identifier field identifies a

single client computer system (see Wood col. 11 lines 50-55).


14.     Regarding claim 28, Wood-Lim disclosed the server computer system has

access to the data structure prior to receiving the request from the client computer (see

Wood col. 12, lines 25-50).


15.     Regarding claim 29, Wood-Lim disclosed the data structure is further configured

to be altered upon being stored, so as to allow a client computer to use additional

authentication methods (see Wood col. 11 lines 30-67).


16.     Regarding claim 30, Wood disclosed a method in a server computer of

authenticating client computer systems, the method comprising:

        receiving an instruction that indicates an authentication methodology that is to be

used to authenticate a client computer system (see col. 11 lines 30-67), the

authentication methodology being selected from multiple authentication methodologies

based on authentication abilities and access rights of the client computer system (see

col. 11 lines 30-67); and

        upon receiving a request from the client computer system to access a service of

the server computer, authenticating the client computer system using the indicated

authentication methodology (col. 12 lines 25-50).

Wood did not explicitly disclose a controlling client computer system containing

authentication instructions. However, in an analogous art, Lim disclosed a Registry

Server 108 containing information on how a user should be authenticated (see col. 6

lines 11-19). Lim also disclosed the Authentication and Authorization Module 114 in the

Access Server 106 used this authentication information to authenticate the user (see

col. 5 line 61 – col. 6 line 10). It would have been obvious to one of ordinary skill in this

art at the time of invention to combine the teachings of Wood and Lim, the rational to

combine is discussed in claim 26 above.


17.     Regarding claim 31, Wood-Lim disclosed the instruction indicates that multiple

authentication methodologies can be used to authenticate the client computer system

and wherein the client computer system is authenticated using one of the indicated

authentication methodologies (see Wood col. 11 lines 30-67).


18.     Regarding claim 32, Wood-Lim disclosed the instruction indicates that the

authentication methodology is to be used to authenticate multiple client computer

systems and wherein the multiple client computer systems are authenticated using the

indicated authentication methodology (see Wood col. 7 lines 35-40 *plurality of client*

*systems authenticate with the gatekeeper/entry handler component 110*).


19.     Regarding claim 33, Wood-Lim disclosed the instruction indicates multiple

authentication methodologies can be used to authenticate multiple client computer

systems and wherein the multiple client computer systems are authenticated using one

of the indicated authentication methodologies (see Wood col. 7 lines 35-40; col. 11 lines

30-67; *the user/client is allowed to choose credential types to be used to authenticate to*

*the server, all the users can use a particular method of authentication, i.e. certificate*

*authority*).


20.     Regarding claim 35, Wood-Lim disclosed the authentication methodology is a

basic HTTP authentication (col. 12 lines 25-30).


21.     Regarding claims 38-41 and 43, the claims are rejected for the same reasons as

the rejections to claims 30-33 and 35 above respectively.


22.     Regarding claims 46-49, the claims are rejected for the same reasons as the

rejections to claims 30-33 above respectively.


23.     <u>Claims 34, 36-37, 42, 44-45, and 50 are rejected under 35 U.S.C. 103(a) as</u>

<u>being unpatentable over Wood-Lim as applied to claims 30, 38, and 49 above, further in</u>

<u>view of AAPA (Applicant Admitted Prior Art).</u>


24.     Regarding claim 34 and 42, Wood-Lim disclosed the invention, substantially as

claimed, as described in claims 30 and 38, but did not explicitly disclose an assertion

authentication.

However, AAPA disclosed assertion methodology is a way of authenticating between client and server (see for example AAPA specification pg 3 lines 1-3). It would have been obvious to one of ordinary skill in this art at the time of invention to combine the teachings of Wood-Lim and AAPA because the teaching of AAPA to allow assertion would improve the trust in between the two systems, as both sides agree to trust each other initially. Furthermore, Wood-Lim's system supports plurality of authentication methodologies, it would have been obvious to incorporate assertion methods with Wood-Lim to improve the functionality of Wood-Lim by allowing for more choices for authentication.

25.    Regarding claims 36 and 44, Wood-Lim disclosed the invention, substantially as claimed, as described in claims 30 and 38, but did not explicitly disclose digest authentication.

However, AAPA disclosed a digest method (see for example pg 3 lines 10-22). It would have been obvious to one of ordinary skill in this art at the time of invention to combine the teachings of Wood-Lim and AAPA, the rationale to combine is discussed in claims 34 and 42 above.

26.    Regarding claims 37 and 45, Wood-Lim disclosed the invention, substantially as claimed, as described in claims 30 and 38, but did not explicitly disclose an NTLM authentication.

However, AAPA disclosed NTLM authentication method (see for example pg 3

lines 23-24). It would have been obvious to one of ordinary skill in this art at the time of

invention to combine the teachings of Wood-Lim and AAPA, the rational to combine is

discussed in claims 34 and 42 above.


27.    Regarding claim 50, the claim is rejected for the same reasons as the rejection to

the combination of claims 34-37 and 42-45 above.


## Conclusion

28.    **Examiner's Note:** Examiner has cited particular columns and line numbers in

the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are

applied to specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the structure

relied on for proper interpretation and also to verify and ascertain the metes and bounds

of the claimed invention.

29.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Angela Widhalm whose telephone number is (571) 272-

1035. The examiner can normally be reached M-F, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax

phone number for the organization where this application or proceeding is assigned is

(571) 273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free).                    AW, 12 April 2006
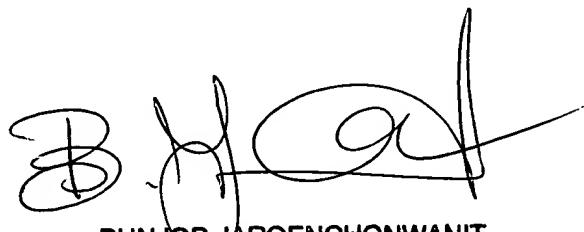
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